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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHARLES J. STEFFENS, DOUGLAS C. STEFFENS, and  
MARK J. HEINTSKILL

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Appeal 2015-003545  
Application 13/493,008  
Technology Center 3600

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Before EDWARD A. BROWN, MICHAEL L. WOODS, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Charles J. Steffens et al. (Appellants)<sup>1</sup> appeal under 35 U.S.C. § 134 from the Examiner's May 8, 2013 non-final decision ("Non-Final Act.") rejecting claims 1–3. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM but denominate the affirmed rejection as a NEW GROUND OF REJECTION.

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<sup>1</sup> According to Appellants, the real party in interest is Steffens Enterprises. App. Br. 2.

## SUMMARY OF INVENTION

Appellants' claimed invention is directed to "a cargo bay cover . . . for a pickup truck." Spec. 1:4–5. Claim 1, the sole independent claim, is reproduced below from page 19 (Claims Appendix) of the Appeal Brief:

1. A clamp comprising:  
a first clamp half having a first clamp horizontal portion, a first clamp vertical portion, and a lower flange forming a shoulder generally opposite said first clamp horizontal portion;  
a second clamp half having a second clamp horizontal portion, a second clamp vertical portion, and a foot engaging said shoulder of said first clamp half, said foot and said shoulder configured such that said foot rides vertically up said shoulder when said second clamp vertical portion moves toward said first clamp vertical portion, wherein said second clamp half is forced vertically up when said second clamp vertical portion moves toward said first clamp vertical portion;  
and  
drawing means for drawing said first and second clamp vertical portions toward one another, wherein said second clamp horizontal portion is forced toward said first clamp horizontal portion as said first and second vertical clamp portions are drawn toward one another.

## REJECTIONS

Claims 1–3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pflieger (US 4,846,431, iss. July 11, 1989) and Love (US 5,131,780, iss. July 21, 1992).

Claims 1–3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pflieger.

## ANALYSIS

### *Summary of Appeal History*

The Examiner issued a Non-Final Office Action on May 8, 2013, which contained a sole rejection of claims 1–3 as being obvious in view of Pflieger and Love. Non-Final Act. 3–4. Appellants appealed, filing an Appeal Brief on August 19, 2013. The Examiner issued an Examiner’s Answer (hereinafter “First Answer” or “Ans.”) on September 12, 2013. The First Answer included a new ground of rejection under which claims 1–3 were deemed to be anticipated by Pflieger, but the First Answer did not include a Technology Center Director’s signature authorizing the new ground of rejection. Ans. 2–3. The Examiner issued a second Examiner’s Answer (hereinafter “Second Answer” or “Second Ans.”) on July 25, 2014 including the required signature. Second Ans. 3. The Second Answer similarly rejected claims 1–3 as being anticipated by Pflieger. *Id.* at 3–6.

Meanwhile, Appellants responded to the First Answer by filing a Reply Brief (hereinafter “First Reply” or “First Reply Br.”) on September 19, 2013. Appellants also filed a subsequent Reply Brief (hereinafter “Second Reply Br.”) on September 25, 2014, arguing that the Second Answer should be ignored because, *inter alia*, the Examiner did not have jurisdiction at the time the Second Answer was issued. Second Reply Br. 2–3.

We agree with Appellants that the Second Answer was improper. Our rules allow for an Examiner to file a “Substitute” Answer only when the Board remands an application to the Examiner for further consideration of a rejection. *See* 37 C.F.R. § 41.50(a)(2). Appellants are correct that when the

First Reply was filed, jurisdiction passed to the Board. *See* 37 C.F.R. § 41.35(a). As such, the Examiner should not have issued an additional paper after the First Reply was filed, and, therefore, we will not consider the Second Answer.

*The Obviousness Rejection*

Initially, we note that the Examiner appears to have withdrawn the obviousness rejection based on Pflieger and Love. *See* Ans. 2 (omitting the obviousness rejection from the list of applicable grounds of rejection). However, as the Examiner has not expressly indicated that the obviousness rejection has been withdrawn, we address it here.

The Examiner finds that Pflieger discloses the clamp substantially as claimed in independent claim 1, but “lacks a[n] exact first clamp horizontal portion and a second clamp horizontal portion.” Non-Final Act. 3. The Examiner finds that Love discloses such horizontal portions, and reasons that it would have been obvious to a skilled artisan to include Love’s horizontal portions in Pflieger’s clamp “to provide more clamping surface area [s]o the clamp is capable of being used on several different applications.” *Id.* at 3–4.

Appellants traverse, arguing that the Examiner’s rejection is conclusory and based on impermissible hindsight reconstruction. App. Br. 12.

We are persuaded by Appellants’ arguments. For a proper rejection, the Examiner must explain how a person of ordinary skill in the art would combine the prior art teachings, and why such a person would be motivated to do so. *See, e.g., In re Chaganti*, 554 F. App’x 917, 922 (Fed. Cir. 2014)

(“It is not enough to say that there would have been a reason to combine two references because to do so would ‘have been obvious to one of ordinary skill.’ . . . Such circular reasoning is not sufficient—more is needed to sustain an obviousness rejection.”). Indeed, this articulated reasoning must include some rational underpinning to support the legal conclusion of obviousness. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Here, the Examiner has not persuasively explained or identified adequate teachings within the identified prior art to support, by a preponderance of evidence, the finding that Love teaches or suggests horizontal portions of first and second clamp halves—we note that the Examiner did not provide any citation or other explanation as to which portions of the Love device were relied upon, or indicate how such portions would be incorporated with Pflieger’s clamp to satisfy the requirements of claim 1.

Accordingly, we do not sustain the rejection of claim 1, nor of its dependent claims 2 and 3, as being unpatentable over Pflieger and Love.

### *The Anticipation Rejection*

#### *Claims 1 and 2*

The Examiner finds that Pflieger discloses all of the elements of independent claim 1, including a first clamp half (upper jaw member 31)<sup>2</sup> having a first horizontal portion (rib 48) and a first vertical portion (rear bearing portion 35), a second clamp half (lower jaw member 32) having a

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<sup>2</sup> Parentheticals refer to the terminology of Pflieger.

second horizontal portion (clamping rib 39) and a second vertical portion (rear bearing portion 38), and drawing means (screw 33). Ans. 2–3 (citing Pflieger, Figs. 1, 3, 4).

Appellants traverse, first arguing that “the Pflieger clamp[] halves move in a single relative direction, which is vertically, as the bolt 33 is tightened. The clamp halves do not move in a second relative direction (e.g. horizontally) as the bolt is tightened.” First Reply Br. 2; *see also* App. Br. 13–14. Continuing, Appellants assert that “the tight interlock of the Pflieger tongue 47 within the groove 46 *prohibits* relative horizontal movement of the clamp halves.” First Reply Br. 2; *see also* App. Br. 14.

We are not persuaded by Appellants’ arguments. Although Appellants argue that Pflieger does not disclose movement of the clamp halves in two, separate directions, no such requirement is seen in claim 1—specifically, there is no requirement for *horizontal* movement. Claim 1 requires “wherein said second clamp horizontal portion is forced toward said first clamp horizontal portion as said first and second vertical clamp portions are drawn toward one another” (App. Br. 19 (Claims Appendix)), but claim 1 does not require the second horizontal clamp portion to move *horizontally* toward the first horizontal clamp portion. Appellants’ arguments are directed at limitations not appearing in the claims, which cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Furthermore, we note that tightening screw 33 causes Pflieger’s lower jaw 32 to move *vertically* toward upper jaw 31. *See* Pflieger, 4:24–64, Figs. 1–4.

Appellants also argue that “Pflieger does not disclose ‘drawing means for drawing said first and second clamp *vertical* portions toward one

another.[']” First Reply Br. 2; *see also* App. Br. 14. Continuing, Appellants assert “only the horizontal portions of the Pflieger clamp move toward one another during tightening. The vertical portions do not move toward one another.” First Reply Br. 3; *see also* App. Br. 14.

We are not persuaded by Appellants’ arguments. As explained above, the entirety of Pflieger’s lower jaw 32—including the Examiner-defined second vertical portion (rear bearing portion 38)—moves toward upper jaw 31 when screw 33 is tightened. Thus, Appellants have failed to apprise us of error.

For the foregoing reasons, we sustain the rejection of claim 1 as anticipated by Pflieger. With respect to the rejection of claim 2, which depends from claim 1, Appellants rely only on the arguments presented above in regard to the anticipation rejection of claim 1. First Reply Br. 3; *see also* App. Br. 15. Accordingly, for the same reasons as discussed above, we also sustain the rejection of claim 2 as anticipated by Pflieger. Because the First Answer did not include the requisite Technology Center Director’s signature, we designate the affirmance as a new ground of rejection.

### *Claim 3*

Claim 3 depends from claim 1 and further requires “wherein the shoulder includes a radiused corner, said foot riding up said radiused corner when said first and second clamp vertical portions are drawn toward one another.” App. Br. 19 (Claims Appendix). The Examiner finds that Pflieger’s first clamp half further includes a lower flange (lower surfaces of rear bearing portion 35 on either side of groove 46) forming a shoulder (groove 46) having a radiused corner, and that Pflieger’s second clamp half



further includes a foot (tongue 47), the foot riding up the radiused corner when the first and second vertical portions are drawn toward each other.

Ans. 2–3.

Appellants traverse, first arguing that “the element of Pflieger that the Examiner identifies as a ‘radiused corner’ is in fact a groove 46” and that “a groove is not a corner.” First Reply Br. 4; *see also* App. Br. 16. Appellants propose to define “corner” as “the point where converging lines, edges, or sides meet” or “the angular part or space between meeting lines, edges, or borders near the vertex of the angle.” First Reply Br. 4; *see also* App. Br. 16.

We are not persuaded by Appellants’ arguments. Even considering the definitions of “corner” proffered by Appellants, Appellants’ conclusory arguments do not apprise us of why the intersections of the sidewalls of groove 46 with the lower surface of rear bearing portion 35 are not corners. Appellants have failed to apprise us of error.

Appellants also argue that “the Pflieger tongue 47 . . . does not ride up the Pflieger groove 46 . . . as the clamp halves are drawn toward one another” because “the Pflieger tongue is horizontally locked within the Pflieger groove during tightening of the clamp.” First Reply Br. 4; *see also* App. Br. 16–17.

We are not persuaded by Appellants’ arguments. Pflieger’s Figure 2 shows the clamp in an initial state, with clamp halves 31, 32 loosely retained together, and with tongue 47 in contact with the lower surface of rear bearing portion 35. Pflieger 4:27–33, Fig. 2. As screw 33 is tightened, lower jaw 32 rotates clockwise (note the arrow in Figure 3), and tongue 47

moves along the lower surface of rear bearing portion 35 and into groove 46. *Id.* at 4:43–45, 63–64, Figs. 3, 4. Thus, prior to tongue 47 becoming fully engaged or locked with groove 46, tongue 47 rides along the lower surface of rear bearing portion 35 and up the inner sidewall of groove 46.

Appellants’ arguments fail to apprise us of error.

For the foregoing reasons, we sustain the rejection of claim 3 as anticipated by Pflieger. Because our reasoning departs from that of the Examiner, and because the First Answer did not include the requisite Technology Center Director’s signature, we designate the affirmance as a new ground of rejection.

#### DECISION

The Examiner’s decision to reject claims 1–3 as anticipated by Pflieger is affirmed, but the affirmance is designated as a new ground of rejection.

The Examiner’s decision to reject claims 1–3 as unpatentable over Pflieger and Love is reversed.

#### NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground

of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)